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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,623	09/30/2003	Bobbye Kaye Whitenton Baylis	2002P16242US01;60,427-605	4194

24500 7590 09/25/2007
SIEMENS CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

MAIL DATE	DELIVERY MODE
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09/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,623

Applicant(s)

BAYLIS ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-10,12,13 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-5,8,21 and 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-30 is/are allowed.
- 6) ☒ Claim(s) 9,10,12,31 and 32 is/are rejected.
- 7) ☒ Claim(s) 13 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, 8, 21, and 22, drawn to a component interface, classified in class 403, subclass 270.
- II. Claims 9, 10, 12, 13, and 23-32, drawn to an air induction component assembly, classified in class 123, subclass 184.61.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product, i.e., the component interface is deemed to be useful as making a connection between panels or capping a container with a lid and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Amended claims 1-5 and 8 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Applicants elected, on the response filed on March 6, 2006, to prosecute the air induction component and its laser weld joint. Claims 1-5, 8, 21, and 22 are now directed to a component interface to form the laser weld joint instead of being directed to the laser weld joint.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-5, 8, 21, and 22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "said second shell includes a second transition surface that transitions directly from said second laser weld surface to said second taper locking surface" recited in claim 31, lines 3-4.

Claim Objections

Claim 23 is objected to because of the following informalities:

regarding claim 23, line 8, "an absorbing material" should be changed to --a laser absorbing material-- so that it is clear that the "absorbing" property pertains to laser absorption. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 31, the recitation “a first transition surface that transitions directly from said first laser weld surface to said first taper locking surface” in lines 2-3 is not supported by the written description requirement. Note that Figure 2A has two surfaces 44 and 45 between the first laser weld surface 28 and the first taper locking surface 30 and none of these surfaces individually transition directly from the first laser weld surface to the first taper locking surface.

Regarding claim 32, the claim depends from claim 31 and therefore does not comply with the written description.

Claims 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 31, the recitation "a first transition surface that transitions directly from said first laser weld surface to said first taper locking surface" in lines 2-3 is misdescriptive and/or inaccurate since there are two transitions surfaces 44 and 45 that transition directly from the first laser weld surface 28 to the first taper locking surface 30 and not just one surface directly. See Figure 2A.

Regarding claim 32, the claim depends from claim 31 and therefore is indefinite.

Claim Rejections - 35 USC § 102

Claims 9, 10, 12, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura, JP-2001-105500 (see English Translation mailed on October 16, 2006).

Regarding claim 9, Nakamura discloses, in Figures 2 and 4, an air induction component comprising a first shell **11**, a second shell **12**, and a laser weld joint area. The first shell **11** is made from a laser-transparent material defining a first weld surface **11b2** (see marked-up attachment provided) and including a first taper locking surface

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A2 opposite from the first weld surface **11b2**. The second shell **12** is made from a laser absorbing material defining a second laser weld surface **A3** and including a second taper locking surface **A4** opposite from the second laser weld surface **A3**. A laser weld joint area **A10** is formed at the first and second laser weld surfaces **A3**. The first taper locking surface **A2** and the second taper locking surface **A4** cooperate with each other. The first laser weld surface **11b2** comprises a first tapered surface **11b2** defining a first angle **A5** and the second laser weld surface **A3** comprises a second tapered surface **A3** defining a second angle **A6** different than the first angle **A5**.

Regarding claim 10, the assembly comprises a predetermined pressure of at least 190 lbs per square inch (this is due to the first shell being on top of the second shell).

Regarding claim 12, a laser beam is applied generally perpendicular to at least one of the first taper surface and the second tapered surface.

Regarding claim 31, the first shell **11** includes a first transition surface **A10** (see marked-up attachment) transitioning from the first laser weld surface **11b2** to the first taper locking surface **A2**, and the second shell **12** includes a second transition surface **A11** that transitions directly from the second laser weld surface **A3** to the second taper locking surface **A4**.

Allowable Subject Matter

Claims 23-30 are allowed.

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 13, the prior art of record does not disclose or suggest an air induction component comprising at least one of a first taper lock surface and a second taper lock surface (claim 13) defining a taper lock angle that is at least twice that of weld taper angles of both a first and second tapered weld surfaces that are different from each other (claim 9, lines 6-8). The closest prior art, Nakamura, JP-2001-105500, discloses different tapered angles of tapered weld surfaces; however, there is no motivation to make the taper lock angle that is at least twice that of weld tapered angles since Fratrack discloses the angles to be the same, or approximately the same;

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regarding claim 23, the prior art of record does not disclose or suggest an air induction component assembly comprising a first shell including a first wall extension having an inner wall surface and an outer wall surface, and extending from a first base end to a first distal end with a first tapered weld surface and a first taper locking surface being formed on the first wall extension. The closest prior art, Nakamura, JP-2001-105500, teaches the wall extension; however, the extension does not extend from a base end and the wall extension in Nakamura merely continuous with the first shell;

regarding claims 24-30, these claims directly or indirectly depend from claim 23; and,

regarding claim 32, the prior art of record does not disclose or suggest an air induction component assembly comprising a second transition surface includes a curved segment that directly faces a flat segment of a first transition surface transitioning from a first laser weld surface to a first taper locking surface. The closest prior art, Nakamura, JP-2001-105500, teaches a flat segment A12 directly facing a second taper locking surface A4.

Response to Arguments

Applicants' arguments filed June 29, 2007 have been fully considered but they are not persuasive.

Applicants argue that “the portion of this figure that is labeled ‘Other end’ is not found in any of the Figures of JP ‘500”. In response, the other end is shown in Figure 2. Figures 3 and 4 are only showing a portion of the cylinder in Figure 2 and one can see that the right side portion is symmetrical as provided in Figure 2. The examiner is merely provided the other half so that the rejection can be understood with respect to the details since the examiner cannot provide markings in Figure 2 when magnified. Applicants argue that “the examiner’s ‘other end’ appears not to correspond in shape to that of the components shown in Figure 3, but instead seems to be shaped more like the components shown in Figure 4”. In response, the argument has been noted. The examiner did not realize that Figure 3 is different than that of Figure 4 and merely flipped Figure 4 to represent the other half of the cylinder in Figure 2. The examiner however has corrected Figure 3 with that of Figure 4 to correspond to the “other end” as marked-up since this provides a symmetrical configuration as shown in Figure 2. Applicants further argue that the angles A5 and A6 are not different. In response, it should be noted that the angles are complementary. The examiner has amended the lead lines of the marked-up figures to clearly show the angles and to see that the angles are different from each other. It should also be noted that the points of references for the angles has been set broadly with respect to the surfaces and angles A5 and A6 qualify as angles equally.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJ.

E.G.

September 17, 2007

Attachment: one marked-up page of Nakamura, JP-2001-105500



GREGORY J. BINDA
PRIMARY EXAMINER

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Nakamura, JP-2001-105500

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